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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/682,412 | 10/10/2003 | Eugenie Charriere | 1004900-000254 | 3439 |
| 21839 7590 12/09/2010 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404 | | | | |
| EXAMINER | | | | |
| SERGENT, RADON A | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1765 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 12/09/2010 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/682,412

Applicant(s)

CHARRIERE ET AL.

Examiner

Rabon Sergeant

Art Unit

1765

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 30, 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/485,533.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

1. Claims 44-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how to interpret the language, "true dimer units in the isocyanate functions", in that it is unclear if the "in" language refers to isocyanate functions literally containing true dimer units or if the language refers to a group of various isocyanate functions wherein one of the functions is a true dimer unit.

2. Claims 44-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Despite applicants' response, it is unclear that adequate support exists for the amended language pertaining to the ratio of true dimer units. Previously applicants presented an amendment on August 22, 2007, wherein applicants argued that the weight ratio of true dimer units/total of isocyanate functions is $\leq 30\%$. The examiner found the basis for support reasonable. Now, applicants present language that states that the ratio of true dimer units in the isocyanate functions to the total composition is less than 15% on a mass/mass basis. While the examiner does not necessarily have an issue with the differing numerical values of " $\leq 30\%$ " and "less than 15%", respectively, as long as support exists for the values, it is unclear how to reconcile the differing language used to set forth or define the same ratio value or entity. The examiner cannot determine if the differing language is defining the ratio equivalently or in

differing ways. If the latter is the case, then it is unclear how the ratio or value, defined differently, meets the written description requirement, in that it is not seen how proper support can be present for different definitions of the same ratio. Furthermore, if the respective definitions are distinct and one is simply incorrect, then an explanation is required on the record. This issue must be resolved, since the limitation is fundamental to examining the claims relative to the prior art of record.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 44-49 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 325941.

The reference discloses polyisocyanates and their reaction with polyester/polyacrylate polyols to yield polyurethanes, wherein the polyisocyanates have contents of uretidinedione groups and biuret groups that are considered to meet applicants' claims. See entire document, especially abstract and examples.

5. Applicants' response has been considered; however, the response is insufficient to overcome the prior art rejection. The position is taken, in view of the nature of the relied upon evidentiary calculations, that the calculations and results must be set forth in the form of a 37 CFR 1.132 declaration. Despite applicants' statement that a declaration was being prepared, at the time of examination, a declaration had not been received. Furthermore, in view of the confusion associated with the support and interpretation of the true dimer unit ratio, set forth

above, the prior art rejection has been maintained, since the ratio is critical to examining the claims relative to the prior art.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1765